

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Mickey Roemer *et al.* **Examiner:** PIERCE, William M.
of:

Application No.: 10/662,605 **Group Art Unit:** 3711

Filing Date: September 15, 2003 **Confirmation No.** 2363

Office Action Date: September 24, 2007 **Docket No.** 83336.0634

Title: METHOD FOR PLAYING A
MATCHING GAME **Customer No.** 66880

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the substitute Examiner's Answer mailed March 24, 2008, pursuant to 37 CFR §41.41.

STATUS OF CLAIMS

Claims 31-61 are pending. Claims 1-30 are canceled. Claims 62-97 are withdrawn.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 33 and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
2. Claims 31, 32, 34, 45, and 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Monte Carlo.
3. Claims 33, 35, 36, 37-44, 46-59, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Monte Carlo in view of Kelly, U.S. Pat. No. 5,882,258, and further in view of the Same Game publication.

ARGUMENTS

Claims 33 and 46: 35 U.S.C. § 112 ¶ 2 indefiniteness

With respect to claim 33, Appellants acknowledge the lack of proper antecedent basis for the claim element “the prizes associated therewith.” Appellants intend to amend claim 33 to provide proper antecedent basis for the claim element when prosecution is re-opened.

With respect to claim 46, Appellants acknowledge that claim 46, as presented, depends from canceled claim 30. Appellants intend to amend claim 46 to properly reflect its dependency to claim 31.

Claims 31, 32, 34, 45, and 60: 35 U.S.C. § 102(b)

The Examiner rejected claims 31, 32, 34, 45, and 60 as being anticipated by Monte Carlo in the substitute Examiner Answer. In so rejecting the claims, the Examiner stated that “Monte Carlo shows displaying a game grid of game pieces at the bottom of pg. 343, player input selecting adjacent game piece that have matching indicia (pg. 344, lns. 1-2), removing the game pieces (ln. 2) and shuffling the remaining game pieces after all matching game pieces have been selected where ‘cards are then moved up to fill the spaces...more cards are then dealt in the usual order to restore the required total of twenty’ (ln. 4-10) and finally repeating the selection removal process (ln. 10).” The Examiner further contends that the action of “moving up the cards is considered to be a ‘shuffling’ process that causes the ‘remaining game pieces to be in a new random order.’” The Examiner also asserts that “since the pieces are in a new location with respect to one another, this is considered to meet the recitation of ‘shuffling’ to create a ‘new random order.’” The term “random” is used in its ordinary meaning, and the Examiner notes that Appellants have not attributed a special meaning to the term in the specification. The Examiner concludes “using appellant’s own definition of shuffling, the steps of Monte Carlo meet these limitations since moving up the cards to fill in ‘creates new adjacent pairs of game pieces.’”

It is respectfully submitted, however, that all of the claimed elements are not disclosed in the Monte Carlo reference. First, contrary to the Examiner’s assertion, Monte Carlo does not disclose a “shuffling” process that causes any remaining pieces to be placed into “a new random

order.” Appellants respectfully submit that the moving up cards to fill in voids is not same as creating a “new random order.” A new random order represents a new sequence or arrangement of game pieces that is unlike the original order of the game pieces.

In contrast, as shown in Monte Carlo, the order of the cards remains the same before and after moving the cards. FIGS. A-C are reproductions of the illustrations of play of the Monte Carlo game. These figures show that the order after pairs of cards are removed (FIG. B) is not the same as the order of the cards after consolidation (FIG. C). FIG. A illustrates the starting configuration of the Monte Carlo game which consists of four rows of five cards are dealt as shown below.

8	K	8	J	2
K	9	7	J	5
3	10	10	A	7
5	Q	6	6	A

FIG. A

After the pairs are removed, the game board looks as follows (where the boxes represent removed cards):

8	□	8	□	2
□	9	7	□	5
3	□	□	□	7
5	Q	□	□	□

FIG. B

As shown in FIG. B, the order of the remaining cards are 8, 8, 2, 9, 7, 5, 3, 7, 5, Q when moving left-to-right and top-to-bottom. The order of the remaining cards after consolidation, as taught by Monte Carlo, reproduced and shown in FIG. C.

8	8	2	9	7
4	3	7	5	Q

FIG. C

Appellants respectfully submit that the order before and after moving the cards is exactly the same order when comparing FIGS. B & C. Accordingly, Appellants respectfully

submit that the Monte Carlo game does not disclose shuffling to create a new order, let alone a new random order, as recited in the pending claims. Using the standard definition of “random,” the game pieces in Monte Carlo are not haphazard or organized without definite aim, direction, rule or method after the cards are moved up (as illustrated in FIG. C). Rather, the game pieces remain in the same sequential order and are moved according to a rule (i.e., “moved up to fill the spaces” in a right-to-left and bottom-to-top manner).

Contrary to the Examiner’s interpretation of Appellants’ specification at p. 11, line 7, Appellants respectfully submit that the “shuffling” recited in the claims is not satisfied by merely moving up the cards as disclosed in Monte Carlo. As recited in the claims and disclosed in the specification, “shuffling” results in a “new random order.” More specifically, Appellants respectfully submit that the disclosed shuffling process (as disclosed in Appellants’ specification at p. 11, line 7) accomplishes two separate functions. Namely, the shuffling process (1) consolidates the remaining pieces and (2) creates new adjacent game piece positions. (*Id.*) For example, as illustrated in FIG. 3, the 6x5 game matrix is composed of 30 game pieces where the adjacent matching pairs are shaded and the remaining unmatched pieces (i.e., 12 game pieces) are unshaded. The order of the remaining, unmatched 12 game pieces when moving left-to-right and top-to-bottom is as follows: spade, spade, diamond, diamond, heart, heart, spade, club, diamond, diamond, club, and heart. The shuffling process is then applied to the remaining 12 game pieces, and the end result is shown in FIG. 4. The 12 game pieces are consolidated in the center of the game matrix, and the game pieces are shuffled such that the order of the game pieces is not the same as the original order shown in FIG. 3. Specifically, in FIG. 4, the order of the 12 game pieces moving left-to-right and top-to-bottom is as follows: diamond, spade, club, diamond, club, heart, diamond, heart, spade, heart, club, and spade. It is clear that the order of the game pieces in FIGS. 3 and 4 has changed as a result of the shuffling process. Stated differently, the “shuffling process creates new adjacencies among the remaining game pieces, thereby potentially creating new adjacent game pieces.” (See, specification, p. 11, lines 16-17). Thus, Appellants respectfully submit that shuffling is not a process of merely “moving up cards” to fill in empty spaces.

Therefore, in view of the foregoing, Appellants respectfully request that the rejection be overturned.

Claims 33, 35, 36, 46-59 and 61: 35 U.S.C. § 103(a)

The Examiner finally rejected claims 33, 35, 36, 46-59 and 61 under 35 U.S.C. § 103(a) as being unpatentable over Monte Carlo in view of Kelly (U.S. Patent No. 5,882,258) and further in view of Same Game.

It is respectfully submitted, however, that each of claims 33, 35, 36, 46-59, which depend from independent claim 31, recite subject matter which is allowable over the cited art. As established above, the cited art does not teach, as is recited in each of claims 33, 35, 36, and 46-59, at least “shuffling any remaining pieces and presenting a new grouping of the remaining pieces, the shuffling causing the remaining pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order.” Accordingly, it is submitted that claims 33, 35, 36, and 46-59 are allowable over the cited art for this reason.

Additionally, Appellants respectfully submit that independent claim 61 is not obvious over Monte Carlo in view of Kelly, and further in view of Same Game for the same reasons as set forth above with regard to claim 31.

Furthermore, Appellants respectfully disagree with the Examiner’s contention that Monte Carlo discloses that “the pieces in Monte Carlo move about in an unpredictable way depending upon which cards are removed when matched, moved upward in the ‘shuffle’ to fill in and new card being dealt.” Appellants respectfully submit that Monte Carlo clearly discloses a logical order in which the cards are consolidated. As shown and described in the figures above, the remaining cards are moved to fill in any spaces, yet the order of the cards remains the same. Specifically, Monte Carlo recites that the “cards are then moved up to fill the spaces, so the sample would become...” (Emphasis added. See, page 344, lines 4-5). If the consolidation of the remaining cards was supposed to be unpredictable, Appellants submit that Monte Carlo would not have used conclusory language (i.e., so) but rather used permissive language. Furthermore, Monte Carlo illustrates a specific end result (See FIG. C above) and does not teach, suggest or imply that any other variations may occur. Reviewing the resultant game board, it is

self-evident that the remaining cards are moved right-to-left and bottom-to-top to fill the empty spaces. Accordingly, the third card in row one (i.e., 8) is moved into the second position of row 1, and the fifth card in row one (i.e., 2) is moved to the next available space (i.e., third position of row 1). Thus, Appellants respectfully submit that the movement of the game pieces in Monte Carlo is not akin to shuffling.

Therefore, in view of the foregoing, Appellants respectfully request that the rejection be overturned.

CONCLUSION

For all of the reasons stated above, Appellants respectfully submit that the Examiner has errors in rejecting claims 31-61. It is respectfully requested that the board reverse the rejection of the claims and allow claims 31-61 to pass to issue. The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name Steptoe & Johnson LLP.

Respectfully submitted,

Date: May 23, 2008


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